

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SAINT LAWRENCE COMMUNICATIONS LLC,
Patent Owner.

Case IPR2017-01077
Patent 7,260,521 B1

Before ROBERT J. WEINSCHENK, SCOTT C. MOORE, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate Proceeding
35 U.S.C. § 317(a); 37 C.F.R. § 42.72

Granting Joint Request to Treat Settlement Agreement as
Business Confidential and to Keep Separate
35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c)

Pursuant to our e-mail authorization of February 23, 2018, Apple, Inc. (“Petitioner”) and Saint Lawrence Communications, LLC (“Patent Owner”) filed a Joint Motion to Terminate Proceeding (Paper 12), requesting pursuant to 35 U.S.C. § 317(a) that this proceeding be terminated. The parties also submitted a copy of their Settlement and License Agreement (Ex. 2024), and filed a Joint Request to Treat Settlement Agreement as business Confidential and to Keep Separate (Paper 13).

The Petition in this proceeding was filed on March 13, 2017. Paper 2. We issued our Institution Decision on October 16, 2017. Paper 7. Patent Owner filed its Response on January 8, 2018. Paper 11. The deadline for Petitioner’s Reply is March 26, 2018 (Paper 8, 7), and Petitioner has not yet filed a Reply. Oral argument (if requested) is scheduled for June 12, 2018. *Id.*

In their Joint Motion to Terminate, the parties represent that their Settlement and License Agreement provides for the termination of this proceeding and related district court litigation involving U.S. Patent 7,260,521 B1. Paper 12, 3. The parties also represent that Exhibit 2024 is a true and correct copy of their Settlement and License Agreement, and that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding. *Id.* at 3–4.

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The parties have filed their Settlement and License Agreement as required by

35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). On this record, we find that termination as to Petitioner is appropriate.

The parties also request termination as to Patent Owner. The Board is not a party to the Settlement and License Agreement, and has authority to proceed and issue a final written decision. 35 U.S.C. § 317(a), 37 C.F.R. § 42.74(a). In view of the early stage of this proceeding and the other circumstances present here, however, we agree that termination as to Patent Owner also is appropriate. Indeed, there are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). We determine that it is appropriate to terminate this proceeding without rendering a final written decision. *See* 37 C.F.R. § 42.72.

Accordingly, it is:

ORDERED that the Joint Motion to Terminate Proceeding (Paper 12) is *granted*, and this proceeding is hereby *terminated*; and

FURTHER ORDERED that the Joint Request to Treat Settlement Agreement as Business Confidential and to Keep Separate (Paper 13) is *granted*, that Exhibit 2024 remain designated as “Parties and Board Only” in the Board’s filing system, and that Exhibit 2024 be kept separate from the file of U.S. Patent 7,260,521.

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Patent 7,260,521 B1

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